

## **REMARKS**

### **Amendments**

#### ***Amendments to the Claims***

Applicant has amended the independent claims to more particularly point out what Applicant regards as the invention. The method claims have also been amended to remove references to "steps" because the claims are not intended to be interpreted under 25 U.S.C. § 112, ¶6. No new matter has been added as a result of these amendments.

### **Rejections**

#### ***Rejections under 35 U.S.C. § 112, second paragraph***

##### **Claims 15-16 and 20**

Claims 15-16 and 20 stand rejected under 35 U.S.C. § 112, second paragraph. Applicant respectfully submits that claims 15-16 and 20, as amended, satisfy the requirements of 35 U.S.C. § 112, second paragraph and respectfully requests the withdrawal of the rejection of the claims under § 112.

#### ***Rejections under 35 U.S.C. § 102(e)***

##### **Claims 1-5, 11-14, 16 and 19-21**

Claims 1-5, 11-14, 16 and 19-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Sezan et al., U.S. Patent No. 6,236,395. Applicant does not admit that Sezan is prior art and reserves the right to challenge it at a later time. Nonetheless, Applicant respectfully submits that Applicant's invention as claimed in claims 1-15, 11-14, 16 and 19-21 is not anticipated by Sezan.

Sezan discloses an audio/video system that analyzes program content to find content that matches a user's preferences.

The Examiner is equating Sezan's A/V system 16 in Figure 2 with Applicant's claimed electronic media element in independent claims 1 and 11, and with Applicant's claimed dedicated electronic media device in independent claim 19. The Examiner has also equated the A/V system 16 of Figure 1 with Applicant's base station as claimed in claim 1.

With regard to claim 1, Applicant respectfully points out that Figures 1 and 2 in Sezan are merely different illustrations of the same A/V system 16. Sezan states that Figure 1 illustrates the functionality and interrelationships among significant components of the A/V system 16. Figure 2 illustrates one combination of modules that embody the functionality of Figure 1. The Examiner is respectfully reminded that the prior art must disclose the identical invention, including function and arrangement, to have anticipation [MPEP 2131]. Thus, the same prior art element cannot be properly used to anticipate two different claim elements that perform different functions. Therefore, the Examiner's reliance on Figure 1 to anticipate Applicant's claimed base station while relying on Figure 2 as anticipating Applicant's claimed electronic media element is improper. Furthermore, there is no disclosure in Sezan that teaches or suggests a base station that is configured to send a user profile to a new electronic media element as claimed in claim 1.

With regard to claim 11, Applicant claims that the electronic media element initially receives a user profile from an interactive personalized viewing system upon installation of the electronic media element into the interactive personalized viewing system. Sezan does not teach or suggest that the A/V system 16 shown in Figure 2 can be installed into an interactive personalized viewing system, much less that it initially receives a user profile upon such an installation.

With regard to claim 19, Applicant claims sending a current user profile to a new dedicated electronic device upon installation of the new dedicated electronic media device into an interactive personalized viewing system. Sezan does not teach or suggest that the A/V system 16 performs the functions claimed in claim 19.

Accordingly, Applicant respectfully submits that the invention claims in claims 1-5, 11-14, 16 and 19-21 is not anticipated by Sezan under 35 U.S.C. § 102(e) and respectfully requests the withdrawal of the rejection of the claims.

### ***Rejections under 35 U.S.C. § 103***

#### **Claims 6-7, 10, 15 and 17-18**

Claims 6, 7, 10, 15 and 17-18 stand rejected under 35 U.S.C. § 103(a) as being obvious over Sezan in combination with Official Notice. Claims 6, 7, 10, 15 and 17-18 depend from one of independent claims 1 and 11. Because Sezan does not disclose each

and every limitation of the independent claims, the Examiner's assertion of Official Notice is insufficient to support a *prima facie* case of obviousness for claims 6, 7, 10, 15 and 17-18.

Furthermore, Applicant respectfully objects to the Examiner's assertion of Official Notice in rejecting claims 6, 7 and 15. The Examiner states that is well-known to use a plurality of tuners with storage elements. However, claims 6, 7 and 15 claim that the electronic media element includes a plurality of tuners, i.e., the tuners are part of the electronic media element. The Examiner is respectfully requested to provide references to support the assertion of Official Notice if the rejection of claims 6, 7 and 15 is maintained in the next Office Action [MPEP 2144.03C].

Accordingly, Applicant respectfully submits that Applicant's invention as claimed in claims 6, 7, 10, 15 and 17-18 is not rendered obvious by Sezan, and respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a).

#### **Claims 8 and 9**

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over Sezan in light of Beach et al., U.S. Patent No. 6,728,713. Beach qualifies as prior art only under 35 U.S.C. § 102(e) because it issued after Applicant's filing date. Applicant does not admit that Beach is prior art and reserves the right to challenge it at a later time. Nonetheless, Applicant respectfully submits that the combination does not teach each and every element of the invention as claimed in claims 8 and 9.

Claims 8 and 9 depend from independent claim 1. Because Sezan does not teach each and every limitation of claim 1, Beach must disclose the elements of claim 1 that are not taught by Sezan to have a proper *prima facie* case of obviousness for claims 8 and 9.

However, Beach discloses a database system that distributes subsets of the data across client devices to replicate a database of television viewing information. Beach contains no teaching or disclosure directed toward either a base station or an electronic media element as claimed by Applicant in claim 1.

Therefore, the combination of Sezan and Beach cannot render obvious Applicant's invention as claimed in claim 8 and 9, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination.

### SUMMARY

Claims 1-21 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-8300 x309.

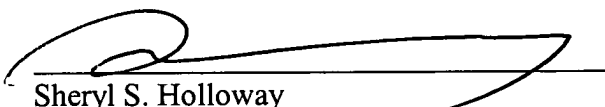
### Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

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